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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/065,527

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Carl Michael Dennison

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EXAMINER

HUNTSINGER, PETER K

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2625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/065,527	Applicant(s) DENNISON ET AL.	
	Examiner Peter K. Huntsinger	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 2/26/10 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. Claim 1 recites "inserting into the original document file a plurality of visual cue object corresponding to the print job ticketing parameters, thereby creating an amended document file, and displaying the plurality of visual cue objects" and "removing from the

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amended document, for specific operations to be performed on the amended document, at least one of the plurality of visual cue objects, removed visual cue objects being included in a print job ticket responsive to performing the specific operations". The Applicant's original disclosure fails to describe that visual cues are inserted into a file, or that removed visual cues are included in a print job ticket in response to performing a specific operation. The Applicant's original disclosure on page 4, paragraph 14 states that "When the document is to be saved or printed, the plug-ins search each page for visual cue objects and remove them, so that the saved or printed document does not include the cues." The visual cues are never stored (i.e. saved) within the document because they are removed prior to saving. Therefore, the Applicant's original disclosure does not describe inserting or removing visual cues from a document file. Claim 9 includes similar limitations.

5. Claim 2 recites "wherein the specific operation is a save operation saving said print job ticket to storage for subsequent forwarding to print." The Applicant's original disclosure fails to describe that removed visual cue objects are included in a print job ticket (as recited in claim 1) responsive to saving said print job ticket to storage. Claim 10 includes similar limitations.

6. Claim 3 recites "wherein the specific operation is initiating an immediate print operation." The Applicant's original disclosure fails to describe initiating an immediate print operation. Claim 11 includes similar limitations.

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7. Claim 4 recites “each said unseen marker being inserted in said file and not displayed”. The Applicant’s original disclosure fails to describe inserting an unseen marker into a file. Claim 12 includes similar limitations.

8. Claim 5 includes limitations for inserting visual cue objects in said file and removing visual cue objects from said file. The Applicant’s original disclosure fails to describe inserting visual cue objects into a file. Claim 13 includes similar limitations.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-5 and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston Patent 6,614,454, and further in view of Lahey Patent 5,999,945.

Referring to claims **1 and 9**, Livingston ‘454 discloses a method comprising:

opening an original document in a document viewing application, said original document being in a file in memory (col. 2, lines 11-36, the computer implemented printer control system includes memory configured to provide an operating system and operative to store files representing at least one document to be printed);

displaying a plurality of original document visual objects of said original document (col. 5, lines 38-53, print preview image 68 of Fig. 3A shows placement of the three staples 69);

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inserting into the original document file a plurality of visual cue objects corresponding to print job ticketing parameters, thereby creating an amended document file (col. 5, lines 38-53, print preview image 68 of Fig. 3A shows placement of the three staples 69), and displaying the plurality of visual cue objects (S5 of Fig. 2, col. 4, lines 2-6);

removing from the amended document, for specific operations to be performed on the amended document, at least one of the plurality of visual cue objects (col. 5, lines 6-27, when a user deselects "Staple this Job Using" in Fig. 3A, the staples displayed on print preview image 68 will be removed), removed visual objects being included in a print job settings responsive to performing the specific operations (col. 5, lines 38-53, the print preview image 68 shows the selected image as it will appear when it is printed [i.e. selected print settings are applied to the printed document]).

Livingston '454 does not disclose expressly printing the amended document responsive to a print job ticket.

Lahey '945 discloses forwarding said amended document and said print job ticket to a printer (col. 8-9 lines 61-67, 1-13, the user can submit the job ticket to the InfoPrint MPC server 6 for printing); and

printing said amended document responsive said print job ticket (col. 5, lines 46-50, the job ticket maintains information on print attributes and the location of the print files which comprise the print jobs).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to utilize a job ticket to store print settings. The motivation for doing so would

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have been to efficiently store print settings in a widely used format. Therefore, it would have been obvious to combine Lahey '945 with Livingston '454 to obtain the invention as specified in claims 1 and 9.

Referring to claims **2 and 10**, Lahey '945 discloses wherein the specific operation is a save operation saving said print job ticket to storage for subsequent forwarding to print (col. 9, lines 14-17, once the user creates a job ticket, the user may save the job ticket 40).

Referring to claims **3 and 11**, Livingston '454 discloses wherein the specific operation is initiating an immediate print operation ("Print" of Fig. 3A, col. 5, lines 17-20).

Referring to claims **4 and 12**, Livingston '454 discloses wherein said step of inserting further includes inserting an unseen marker with each of the plurality of visual cue objects, each said unseen marker being inserted in said file and not displayed, and wherein said step of removing the at least one of the plurality of visual cue objects further includes locating the unseen marker (col. 5, lines 38-53, print preview image 68 of Fig. 3A shows placement of the three staples 69 [It is inherent that the program of Livingston needs to track of whether the option for staples has been selected or not. A register or variable present in the program code indicates the selection of the user and is and unseen marker. The selection or deselection of the "Staple this Job Using" button would require locating the register or variable to record the result.]).

Referring to claims **5 and 13**, Livingston '454 discloses wherein said step of inserting further includes maintaining a list of each of the plurality of visual cue objects inserted (col. 5, lines 20-27, as is shown in Fig. 3A of Livingston, the option of stapling is

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provided sequentially is a list format. The user is able to visible view the list and determine which staples that are desired to be removed) and wherein said step of removing the at least one of the plurality of visual cue objects further includes referencing the list and identifying the at least one of the plurality of visual cue objects to be removed (col. 5, lines 6-27, when a user deselects "Staple this Job Using" in Fig. 3A, the staples displayed on print preview image 68 will be removed).

11. Claims 6-8 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston Patent 6,614,454 and Lahey Patent 5,999,945 as applied to claims 1 and 9 above, and further in view of Simpson Publication 2002/0184305.

Referring to claims **6 and 14**, Livingston '454 discloses wherein said document viewing application is a document editor and the steps of inserting and removing are performed, but does not disclose expressly the steps being performed by a plug-in to a document editor.

Simpson '305 discloses plug-in to a document editor providing a plug-in interface (page 1, paragraph 3).

At the time of the invention, it would have been obvious for a person of ordinary skill in the art to apply the print preview program of Livingston as a plug-in to a document editor. The motivation for doing so would have been to increase the flexibility of a program by allowing its incorporation into other programs. Therefore, it would have been obvious to combine Simpson '305 with Livingston '454 to obtain the invention as specified in claims 6 and 14.

Referring to claims **7 and 15**, Livingston '454 discloses applying certain of the print job ticketing parameters to all pages of the document file ("Apply changes to: All Pages" of Fig. 3B).

Referring to claims **8 and 16**, Livingston '454 discloses applying certain of the print job ticketing parameters to selected pages of the document file ("Apply changes to: All Pages" of Fig. 3B, The changes are shown to apply to selecting all pages).

12. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston Patent 6,614,454 and Lahey Patent 5,999,945 as applied to claims 1 and 9 above, and further in view of Koppolu Patent 6,268,924.

Referring to claims **17 and 19**, Livingston '454 discloses displaying the plurality of visual cue objects, but does not disclose expressly the print preview being a thumbnail.

Koppolu '924 discloses a print preview being a thumbnail (col. 6, lines 27-37).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a print preview utilizing a thumbnail graphic. The motivation for doing so would have been to utilize a space saving image format. Further, a thumbnail file is standard format well known in the art. Therefore, it would have been obvious to combine Koppolu et al. with Livingston '454 to obtain the invention as specified in claims 17 and 19.

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13. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Livingston Patent 6,614,454, Lahey Patent 5,999,945 and Simpson Publication 2002/0184305 as applied to claims 6 and 19 above, and further in view of Koppolu Patent 6,268,924.

Referring to claims **18 and 20**, Livingston '454 discloses monitoring the print preview for the current page selection (col. 5, lines 39-44).

Simpson '305 discloses a plug-in to a document editor providing a plug-in interface (page 1, paragraph 3).

Livingston '454 does not disclose expressly the print preview being a thumbnail.

Koppolu '924 discloses a print preview being a thumbnail (col. 6, lines 27-37).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a print preview utilizing a thumbnail graphic. The motivation for doing so would have been to utilize a space saving image format. Further, a thumbnail file is standard format well known in the art. Therefore, it would have been obvious to combine Koppolu '924 with Livingston '454 and Simpson '305 to obtain the invention as specified in claims 18 and 20.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter K. Huntsinger/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625